



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/745,285      | 12/21/2000  | Rudolph W. Frey      | 24430.13            | 7415             |

7590 05/20/2002

Auzville Jackson, Jr.  
8652 Rio Grande Road  
Richmond, VA 23229

EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 05/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/745,285

Applicant(s)

Frey

Examiner

J. Shay

Group Art Unit

3709

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on February 4, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-48 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-48 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6, 7, 8, 9
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 15-18 and 45-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification is silent on the spacing required "so the eye can clear".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 30 are virtually identical except for the recitation that the pulses are "spaced apart from" (claim 30) and "removed from" (claim 6) each other.

These terms appear identical in scope and each term lacks any particular definition in the specification, thus claims 6 and 30 are substantial duplicate of each other. This situation also throws the exact meaning of the terms "spaced apart from" and "removed from" as used in the other claims into doubt. Claims 12 and 13 do not further limit claim 10. Claims 15-18 and 45-48 are indefinite as the term "so that the eye can clear" lacks antecedent basis in the specification and does not make sense in the context of a photorefractive procedure, since,

the cornea does not usually become clear until days after the laser tissue removal. Thus claims 15-18 and 45-48 will not be treated further. Claims 38 and 42 are both indefinite because "the first shot" and "the third shot" in each of the claims lacks positive antecedent basis.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-14 and 19-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Warner et al.

Warner et al teach folding back a corneal flap (see column 3 lines 28-44) and incorporates U.S. Patent 4,665,913 which discloses a non-overlapping fixed size spot scanning method as claimed see column 3 line 63 to column 4 line 50 – whereas the first shot of the method is considered the first shot or pulse of the claims; the e.g. two hundredth shot of the method is considered the second shot or pulse recited in the claims; the e.g. four hundredth shot of the method is considered the third shot or pulse of the method, and the six hundredth shot of the method is considered the fourth shot of the claims.

7. Claims 5, 6, 11, 14, 22-24, 28-30, 34-36, and 41-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by L'Esperance Jr ('913).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-14 and 19-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,980,513 in view of L'Esperance, Jr. ('913). It would have been obvious to use the ablation pattern of L'Esperance, Jr. ('913), since this is suitable for corneal ablation, thus producing a method such as claimed.

10. Claims 1-14 and 19-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim all the claims in each of of copending Application No. 09/742,884; 09/742,885; 09/745, 191; 09/745,193; 09/745; 194; and 09/794,195 in view of L'Esperance, Jr. ('913) The teachings of L'Esperance Jr. ('913) and the motivation for combination thereof are essentially those already set forth above, thus producing a method such as claimed.

This is a provisional obviousness-type double patenting rejection.

The examiner acknowledge applicant's information disclosure statements of April 17, 2001; October 9, 2001; and February 4, 2002; with respect to the submission of October 9, 2001, which was apparently was not accompanied by copies of

Application/Control Number: 09/745,285  
Art Unit: 3739

Page 5

references, the examiner notes that such a submission is not in conformance with MPEP 609. The examiner has considered the approximately 100 US patent references cited in the submission, however, the approximately 50 items of foreign and non-patent literature have not been considered.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215

David Shay:bhw

April 24, 2002



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330